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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,798	10/18/1999	TOSHIHIKO MIURA	1004.1063/JD	1817

21171 7590 01/14/2005

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WASHINGTON, DC 20005

EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n No.

09/419,798

Applicant(s)

KAWASAKI ET AL.

Examiner

Monique R Jackson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

THE REPLY FILED 28 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): the rejection under 35 USC 112, 1st paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-7.

Claim(s) withdrawn from consideration: 8.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

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Continuation of Item No. 5. NOTE: The Applicant's arguments filed 12/28/04 have been considered but are not persuasive with respect to the obviousness rejection. The Applicant first argues that Sagawa includes a powder size far larger than that recited in claim 1 wherein Sagawa teach ideally 0.1 to 50 microns but the instant invention has an upper limit of 15 microns wherein the 15 micron dimension is allegedly significant because filler particles over 15 microns would only fill larger spaces and leave smaller spaces empty. The Applicant argues that Sagawa allegedly does not take into consideration that the surface roughness of the magnet is lessened by the powder size. However, as previously recited, Sagawa clearly teach that the magnet is coated with a resin and a compacted powder layer, wherein the resin is a thermosetting resin and the grain size of the powder material (*filling material*) depends of the size of the work piece to be coated, the thickness of the coating, and the material of the powder, and **the grain size is usually within a range from 0.05 to 500 μ m, and more preferably 0.1 to 50 μ m wherein the finer the powder material is, the smaller the striking force is and the surface roughness is lessened** (Col. 6, lines 5-12; Col. 13, lines 53-69.) Hence, Sagawa clearly disclose a powder size range that encompasses the instantly claimed range and though Sagawa teach a broader range than instantly claimed, Sagawa clearly provides guidance to one skilled in the art to utilize routine experimentation to determine the optimum powder size wherein Sagawa teach that the powder size is a result-effective variable affecting the surface roughness with finer powder resulting in lower surface roughness. The Applicant further argues that Sagawa does not teach or suggest the significance of a surface roughness of less than 3 microns and also appears to argue the references separately as opposed to in combination as presented in the rejection. In response to applicant's arguments against the references individually, one cannot show nonobviousness by

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attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As previously recited, though Sagawa et al teach that the finer the powder materials, the smaller the striking force and lower the surface roughness, and that the protective coating assists in smoothening the surface of the magnet, Sagawa et al do not teach the surface roughness of the magnet as instantly claimed. However, it is noted that with regards to resin-bonded magnets, the surface roughness is an important characteristic of the performance of the magnet with regards to corrosion resistance of the magnet as taught by Nakayama et al wherein an improvement in corrosion resistance can be obtained by reducing the surface roughness of the magnet (Col. 2, lines 50-60.) Nakayama et al further teach that a surface roughness of about 1 micron or less is preferred (Col. 2, lines 54-60), wherein the Examiner notes that Nakayama et al was not relied upon in terms of how the desired surface roughness is obtained but instead utilized as a secondary reference to show that it was known in the art prior to the instant invention that surface roughness is an important characteristic of the performance of resin-bonded magnets and a result-effective variable wherein a preferred surface roughness is about 1 micron or less. Therefore, one having ordinary skill in the art at the time of the invention would have been motivated to provide the surface of the magnet taught by Sagawa et al with a small surface roughness, preferably less than one micron, because, as taught by Nakayama et al, a decrease in surface roughness provides improved corrosion resistance. Hence, the Examiner maintains her position that the instant invention would have been obvious over the teachings of the prior art references as combined and discussed in detail in the prior office action.

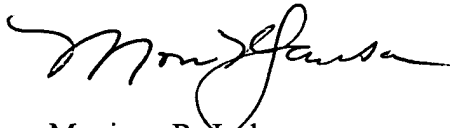
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508.

The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
Primary Examiner
Technology Center 1700
January 12, 2005